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10/575,705	04/13/2006	Yuichi Futa	2006_0545A	2366
52349 7590 04/24/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
LIM, SENG HENG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,705

Applicant(s)

FUTA ET AL.

Examiner

SENG H. LIM

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-14, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION
Response to Amendment

This office action is in response to the amendment filed on 1/26/2009 in which applicant amends claims 1-2, 6, 9-11, 14; added claim 17; and responds to the claim rejections. Claims 1-4, 6-14, 16 and 17 are pending.

Response to Arguments

Applicant's arguments with respect to claim 1/26/2009 have been considered but they are not persuasive. Applicant argues that:

Miyamoto et al does not disclose "a permission information reading unit operable to read from the game recording medium permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the game execution apparatus..." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner agrees with the applicant and included secondary reference of Borge to teach the permission limitation. Please see claim 1 of previous action, which was rejected under 35 U.S.C. 103(a) enabling examiner to use multiple combination of references to teach all the elements of a claim.

Regarding applicant's arguments to newly added limitations to amended claims, please refer to bolded sections below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the same character" in line 19. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (EP0991007A1) in view of Borge (US 2005/0059483 A1).

Re Claim 1. Miyamoto discloses a game system comprising a first game execution apparatus and a second game execution apparatus that have different internal structure from each other (Fig. 4), wherein the first game execution apparatus [0038] includes: a first program reading unit operable to read, from a first game recording medium, a first game program that indicates a procedure of a game [0020]; a first character reading unit operable to read, from a portable recording medium (15, Fig.1 or 35, Fig. 4), **predetermined character data that indicates a plurality of attributes of a common character that appears in the game (i.e. characteristics of common or standard characters as well as character's power levels; [0029, 0046])**; a first input unit (game controller, 24, Fig. 4) operable to receive an inputting operation from a user; and a first game execution unit (CPU) operable to proceed with the game according to the inputting operation received at the first input unit and the procedure indicated by the first game program, and to cause the character appear in the game in accordance with the predetermined character data read by the first character reading unit [0042], and the second game execution apparatus [0044] includes: a second program reading unit operable to read, from a second game recording medium (25, Fig. 1), a second game program that indicates the procedure of the game [0021]; a second character reading unit operable to read from the portable recording medium, **the same character data as the predetermined character data read by the first character reading unit (i.e. the portable medium 35 could be the main game disc**

carrying all the common character data and portable medium 25 could be cartridge holding player's updated character attributes, wherein the data of the updated character attributes are the same or present on the main game disc) [0029, 0050]; a second input unit operable to receive an inputting operation from the user; and a second game execution unit operable to proceed with the game according to the inputting operation received at the second input unit and the procedure indicated by the second game program, and to cause the predetermined character appear in the game in accordance with the character data read by the second character reading unit wherein the predetermined character has plurality of attributes [0048].

Miyamoto does not disclose the apparatus comprising a first and second permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidenced by Borge [0027]. In this instance once an unlocked characteristic of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be the changes of the attribute of a character because it was already unlocked. It is obvious to

one of ordinary skill in the art that each game execution apparatus would have its own permission information reading unit, hence inputting the game recording medium to a second game execution apparatus requires the second permission information reading unit to read second permission information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking character features to increase player's excitement with the game by providing new/enhanced features (Abstract).

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Re Claim 2, 8, 16 & 17. Miyamoto discloses a game execution apparatus comprising program reading unit operable to read, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading unit operable to read, from a portable recording medium, **character data that indicates an of attributes of a common character that appears in the game (i.e. characteristics of common or standard characters as well as character's power levels; [0029, 0046])**; an input unit operable to receive an inputting operation from a user [0064]; and a game execution unit operable to proceed with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and to cause the character to appear in the game in accordance with the character data

read by the character reading unit wherein the character has plurality of attributes [0048].

Miyamoto does not disclose wherein the apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidence by Borge [0027]. In this instance once an unlocked characteristics of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be the changes of the attribute of a character because it was already unlocked or not change the attribute of a character if it's not unlocked yet (*which also rejects claim 8 & 16*). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking character features to increase player's excitement with the game by providing new/enhanced features (Abstract).

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in

combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Re Claim 3. Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium; Borge discloses a request of character data from a server via a network and writing the obtained character data to a recording medium (Fig. 1). At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

Re Claim 4. Miyamoto discloses the apparatus further includes a determining means for determining based on the data memory means if it is usable or not (i.e. authenticity) and an inapplicable notifying means notifies inapplicability when not usable is determined by the use determining means [0022]. The character reading unit would read the character data when the authenticity has been ensured.

Re Claim 6-7. Miyamoto discloses the apparatus to include a game recording medium wherein it permits change to the character's characteristics and prohibits the change of the character's characteristics according to permissible information based on a player-by-player basis in a manner discriminating one's data from others [0054]. Each new captured character is stored or written into the portable recording medium or overwrites the pre-existing character data with the new one when the character changes [0054-0055].

Re Claim 9. Miyamoto discloses an external storage unit comprising a storage unit; the external storage unit authenticates the main unit peripheral interface (i.e. game apparatus) [0022] and implicitly an output unit operable to, when the authenticity has been ensured, read the data from the storage unit and output the data to the game apparatus, wherein the **common** character has plurality of attributes [0022], as discussed in claim 1 above.

Miyamoto does not disclose a portable recording medium to store therein a permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit changes the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibits an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidenced by Borge [0027]. In this instance once an unlocked characteristic of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be a code to let the game execution apparatus know to change the attribute of a character because it was already unlocked or not change the attribute of a character if it's not unlocked yet. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking

character features to increase player's excitement with the game by providing new features.

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Re Claim 10. Miyamoto discloses a game execution method comprising program reading step of reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; reading, from a portable recording medium, **character data that indicates an of attributes of a common character that appears in the game (i.e. characteristics of common or standard characters as well as character's power levels; [0029, 0046])**; receiving an inputting operation from a user [0064]; and proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and cause the character to appear in the game in accordance with the character data read by the character reading unit [0048], wherein the character has plurality of attributes.

Miyamoto does not disclose that the apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution

apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidence by Borge [0027]. In this instance once an unlocked characteristics of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be a code to let the game execution apparatus know to change the attribute of a character because it was already unlocked or not change the attribute of a character if it's not unlocked yet. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking character features to increase player's excitement with the game by providing new features.

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Re Claim 11. Miyamoto discloses a game execution program comprising reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; reading, from a portable recording medium, a common character data that indicates a characteristic of a character that appears in the game (i.e. **characteristics of common or standard characters as well as character's power**

levels; [0029, 0046]); receiving an inputting operation from a user [0064]; and proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048], wherein the character has plurality of attributes.

Miyamoto does not disclose wherein the apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidence by Borge [0027]. In this instance once an unlocked characteristics of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be a code of some sort to let the game execution apparatus know to change the attribute of a character because it was already unlocked or not change the attribute of a character if it's not unlocked yet. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking character features to increase player's excitement with the game by providing new features.

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Re Claim 12-13. Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium; Borge discloses a request of character data from a server via a network and writing the obtained character data to a recording medium (Fig. 1). At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

Re Claim 14. Miyamoto discloses a computer-readable recording medium that stores a game execution program wherein the program has a game execution apparatus to execute reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; reading, from a portable recording medium, common character data that indicates a characteristic of a character that appears in the game (**i.e. characteristics of common or standard characters as well as character's power levels; [0029, 0046]**); receiving an inputting operation from a user [0064]; and proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the

character appear in the game in accordance with the character data read by the character reading unit wherein the character has plurality of attributes [0048].

Miyamoto does not disclose wherein the apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus, and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed. However, the concept of unlocking game characteristics of characters such as traits, weapons, weaknesses, etc is well known in the art as evidence by Borge [0027]. In this instance once an unlocked characteristics of a character is unlocked and saved in a storage medium, a player can go to other game execution apparatus and load the unlocked characteristics of the character. The permission information would be a code of some sort to let the game execution apparatus know to change the attribute of a character because it was already unlocked or not change the attribute of a character if it's not unlocked yet. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miyamoto in view of Borge to include an unlocking character features to increase player's excitement with the game by providing new features.

The common character commonly appears in the game by the first game execution unit and by the second game execution unit (because the first and second game unit are using two different portable medium (25 & 35) in

combination with one another, wherein the data from each portable medium correlates with one another), [0050].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **SENG H. LIM** whose telephone number is (571)270-3301. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. H. L./

Examiner, Art Unit 3714

/Corbett Coburn/
Primary Examiner
AU 3714